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EXAMINER

STOKLOSA, JOSEPH A

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3762

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/28/2009 have been fully considered but they are not persuasive.
2. Applicant argues that Kuzma in view of Charvin fail to teach preventing foldover of the tip member. Examiner respectfully disagrees. Examiner considers the tapered conical tip as taught by Kuzma in view of Charvin to necessarily substantially prevent foldover of the tip member. A tapered tip will provide deflection of shearing forces such that the moment arm is in effect shorter and thereby prevent foldover. This is a factual and well known rigid body mechanics theorem and longitudinally displaces the moment of inertia to the proximal end which will resist foldover.
3. Further, Examiner considers the claimed shape and dimensions of the tip, as written, to be met by Kuzma in view of Charvin, in that Kuzma in view of Charvin teach a conical tapered tip dimensioned to fit in the cochlea of a patient and therefore also being dimensioned to prevent substantial foldover of the tip member since applicant has failed to further limit the claimed shape and dimensions. Examiner has further interpreted the limitation of "substantially preventing foldover" to only require that the tip member in some way reduce foldover of the tip. In light of this Examiner also considers that the native conical tapered tip prevents fold over when subjected to the slightest of deflection forces since the tip is not in a native bent or folded over configuration.
4. Applicant argues that Charvin fails to teach preventing foldover of the tip as suggestion or motivation for modifying Kuzma. Examiner respectfully disagrees.

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Examiner considers the conical tapering that is taught by Charvin to provide a predictable result with a reasonable expectation of success due to the geometry and similar dimensions of the electrode array. In addition Examiner has previously presented additional predictable results that are yielded by the combination of Kuzma in view of Charvin, and it appears Applicant has misinterpreted these to only apply to the limitation of preventing foldover. In other words, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner has clearly articulated that Kuzma teaches a flexible tip member, but fails to teach the conical tapering of the tip member. Examiner has relied upon Charvin for teaching this element of the tip member, and wherein the combination of Kuzma in view of Charvin yield a flexible conical tip member that substantially prevents foldover.

6. Applicant argues that "a constant strength cantilever beam" must have uniform bending stresses from the tip member throughout to the junction. Examiner respectfully disagrees. Applicant has not set forth a special definition that constant-strength cantilever beam must have uniform bending stresses, but rather Applicant's specification states that the tip member will have uniform bending stressing throughout

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will have uniform bending stresses from the tip member all the way to the junction.

Therefore, Applicant must state in the claims that the constant-strength cantilever beam has uniform bending stresses from tip to junction if Applicant wishes for Examiner to extend weight to this limitation.

7. Examiner further considers the cantilever beam tip member configuration as taught by Kuzma in view of Charvin to be constant strength as the tip member is comprised of a homogenous mixture of LSR-25 since the material properties (strength) will be the same throughout the entire length of the tip. It is of note that Applicant's Claim 29 as written fails to claim bending stresses at one end will always equal bending stresses at the opposing end and throughout the tip.

8. For the sake of argument and with respect to claim 20; Examiner considers the flexible conical tapered tip as taught by Kuzma in view of Charvin to also exhibit uniform bending stresses throughout the length of the tip member since Kuzma in view of Charvin has sufficiently taught the structure of the claimed tip (i.e. flexible, conical, and tapered with a fixed end). In light of this Examiner must consider the tip member as taught by Kuzma in view of Charvin to perform in the same manner as Applicant's claimed tip member.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH STOKLOSA whose telephone number is (571)272-1213. The examiner can normally be reached on Monday-Friday 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/George R Evanisko/
Primary Examiner, Art Unit 3762

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11/12/2009